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In re application of

Tour et al.

Serial No. 10/738,459

Filed: December 17, 2003

For: USE OF MICROWAVES TO CROSSLINK CARBON NANOTUBES

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION, filed May 1, 2007.

On September 12, 2006, a non-final office action was mailed to applicant rejecting all of the claims. A reply to the office action was filed by applicants on January 8, 2007. In the reply, applicants made amendments to the claims. A final office action was mailed by the office on March 14, 2007 containing new grounds of rejection. On May 1, 2007, the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the March 14, 2007 office action.

Petitioner's position for the withdrawal of the finality is that the new grounds of rejection in the final office action were not necessitated by applicant's amendments to the claims.

DECISION

Section 706.07 of the MPEP states:

706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

In the reply, filed January 8, 2007, to non-final rejection of September 12, 2006, applicants amended the independent claims to include the step of providing the carbon nanotubes. The examiner established a new grounds of rejection in the final office action of March 14, 2007. The petitioner argues that the amendment did not warrant a new search and that the amendment did not change the scope of the claims, as carbon nanotubes must be present (i.e. provided) in order to perform the crosslinking. The petitioner's argument as merit. The amendment to the

claims of January 8, 2007, merely positively adds a step of providing carbon nanotubes. The claims as rejected in the non-final action of September 12, 2006, required irradiating and crosslinking the carbon nanotubes. The carbon nanotubes must have been present (i.e. provided) in order to have been irradiated and crosslinked, in the claims as rejected in the September 12, 2006 non-final office action. Therefore, it is deemed that the amendment of January 8, 2007 did not change the scope of the claims. Because scope of the claims were not changed by the amendment of January 8, 2007, it is deemed that the new grounds of rejection in the final office action mailed March 14, 2007 were not necessitated by amendment.

Therefore, the finality of the office action was premature. Accordingly, the petition for withdrawal of finality is **GRANTED**.

It is also pointed out that while the finality of the office action has been withdrawn, the rejection still stands. It is also noted that a response was filed on May 14, 2007. The application will be forwarded to the examiner for consideration of that response.

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